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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,756	05/14/2001	Robert C. Gardiner	283_299	8889

7590 12/16/2004

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Syracuse, NY 13202

EXAMINER

TRAN, ELLEN C

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,756

Applicant(s)

GARDINER, ROBERT C.

Examiner

Ellen C Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-59 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: original application filed 05/14/2001.
2. Claims 1-59 are currently pending in this application. Claims 1, 28, 42, and 58 are independent claims.
3. A pre-amendment was received on 14 January 2002, however applicant needs to submit support in specification for independent claim 58 in order for claims 58 and 59 to be considered. Specifically in previously submitted application no reference was provided for downloading an initial key into the portable keying device.

Election/Restrictions

4. Claims 1, 28, and 42, link(s) inventions 2-14, 15, 16, 17, 18-19, 20-21, 22-27, and 49-57. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1, 28, and 42. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the

provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-15, 28-38, and 42-48 are drawn to a transfer key mechanism in a portable device utilizing non-volatile memory mechanism, RF communications, and a defined handshake, protocol mechanism classified in class 713 subclass 172.

II. Claims 1, 12, 16 are drawn to a transfer key mechanism in a portable device utilizing a battery-backed RAM memory device class 711 subclass 101.

III. Claims 1, 12, 17 are drawn to a transfer key mechanism in a portable device utilizing a Ferro RAM memory device class 365 subclass 65.

IV. Claims 1, 18, 19, 28, and 39 are drawn to a transfer key mechanism in a portable device utilizing an optical communication mechanism class 455 subclass 151.

V. Claims 1, 20, 21, 28, 40, and 41 are drawn to a transfer key mechanism in a portable device utilizing an audio communication mechanism class 455 subclass 130.

VI. Claims 1, 22-27 are drawn to a transfer key mechanism in a portable device utilizing an I/O external communication mechanism class 340 subclass 7.54.

VII. Claims 42, 43, 49-57 are drawn to a transfer key mechanism in a portable device detailing electrical components class 257 subclass 202.

VIII. Claims 58 and 59 are drawn to a transfer key mechanism in a portable device utilizing that is able to download an initial key into the device class 713 subclass 201.

6. The inventions are distinct, each from the other because of the following reasons:

Inventions II-VIII are related in invention I as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention (I) has separate utility such as transfer key mechanism with a non-volatile memory.

Inventions I, III-VIII are related in invention II as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention (II) has separate utility such as transfer key mechanism with a battery-backed RAM memory.

Inventions I, II, and IV-VIII are related in invention III as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention (III) has separate utility such as transfer key mechanism with a Ferro RAM memory.

Inventions I-III and V-VIII are related in invention IV as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention (IV) has separate utility such as an optical communication mechanism.

Inventions I-IV and VI-VIII are related in invention V as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention (V) has separate utility such as an audio communication mechanism.

Inventions I-V, VII, and VIII are related in invention VI as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention (VI) has separate utility such as an external interface communication mechanism.

Inventions I-VI and VIII are related in invention VII as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention (VII) has separate utility such as transfer key mechanism with various electronic components.

Inventions I-VII are related in invention VIII as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention (VIII) has separate utility such as transfer key mechanism with the ability to download an initial into the portable device. (See MPEP § 806.05(d)).

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-VIII, the search required for Group II is not required for Groups I, and III-VIII, the search required for Group III is not required for Groups I, II, and IV-VIII, the search required for Group IV is not required for

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Groups I, II, III and V-VIII, the search required for Group V is not required for Groups I-IV and VI-VIII, the search required for Group VI is not required for Groups I-V, VII, and VIII, the search required for Group VII is not required for Groups I-VI and VIII, the search required for Group VIII is not required for Groups I-VII; restriction for examination purposes as indicated is proper.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the -fee required under 37 CFR 1.17(i).

11. On 2 December 2004, examiner spoke with attorney of record Stephen Rosenholm at (315) 425-9000 ext. 236, who later indicated by voice message a decision as to which group to elect could not be made at this time.

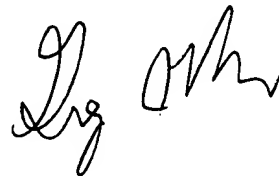
Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ellen Tran
Patent Examiner
Technology Center 2134
9 December 2004

A handwritten signature in black ink, appearing to read 'G. Morse', is positioned above the printed name of Gregory Morse.

GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100